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April 18, 2003

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

Re: **Application Serial No.:** 09/193,787
Confirmation No.: 2446
Appellants: Jay Paul Drummond, et al.
Title: Automated Banking Machine
Apparatus and System
Docket No.: D-1077+1

Sir:

Please find enclosed the Reply Brief of Appellants pursuant to 37 C.F.R. § 1.193(b) in triplicate, in response to the Examiner's Answer dated March 11, 2003, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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D-1077+1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of)	
Jay Paul Drummond, et al.)	
)	
Serial No.: 09/193,787)	Art Unit 3621
)	
Confirm. No.: 2446)	
)	
Filed: November 17, 1998)	Patent Examiner
)	Jalatee Worjloh
)	
Title: Automated Banking Machine)	
Apparatus and System)	

Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, D.C. 20231

**REPLY BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.193(b)**

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 1.193(b), in triplicate, concerning the above-referenced Application.

REMARKS

The Examiner's Answer ("Answer") dated March 11, 2003 is acknowledged.

Reply to the "(10) Grounds of Rejection" section of the Answer

The Answer includes a "Grounds of Rejection" section beginning on page 3. This section includes substantially the same grounds of rejection set forth in the Office Action (dated September 16, 2002) from which the appeal was taken. Appellants respectfully submit that the issues mentioned in this section have already been addressed in the Appeal Brief. Therefore, please note Appellants' remarks in the Appeal Brief.

Reply to the "(11) Response to Argument" section of the Answer

The Answer includes a "Response to Argument" section beginning on page 13.

35 U.S.C. § 112, second paragraph

Appellants respectfully submit that dependent claim 27 is not indefinite for the reasons already set forth in the Appeal Brief. Nevertheless, Appellants are willing to amend claim 27, as the Office suggests (and apparently agrees to permit). That is, Appellants are willing to revise claim 27 to include mutually agreeable language. Therefore, since both the Office and Appellants agree to resolve the matter by amendment, the 35 U.S.C. § 112 rejection no longer appears to be an issue.

35 U.S.C. § 102(e)

Appellants have presented several reasons in the Appeal Brief (beginning on page 11 thereof) as to why Zeanah does not constitute prior art against the recited invention. Appellants have sworn back to prior to July 7, 1996. Furthermore, Zeanah is not entitled to the October 31, 1996 filing date of provisional application 60/029,209.

The Examiner's concerns about expressing remarks that may effect the validity of the Zeanah patent are acknowledged. However, Zeanah is not entitled to the benefit of the provisional's earlier filing date. *New Railhead Mfg., LLC v. Vermeer Mfg. Co.*, 298 F.3d 1290, 63 USPQ2d 1843 (Fed. Cir. 2002). *Enzo Biochem Inc. v. Gen-Probe Inc.*, 296 F.3d 1316, 63 USPQ2d 1609 (Fed. Cir. 2002).

Regarding the teaching of Zeanah, Appellants respectfully disagree with the Office's interpretation thereof. Appellants' Appeal Brief provides a detailed explanation as to why Zeanah does not anticipate the claims. The relied upon (Answer pages 15-16) cited section of Zeanah at col. 21, lines 12-32 and 47-52 does not teach the recited apparatus.

The Answer asserts that the cited section "illustrates a transaction function device operating responsive to a browser processing an HTML document instruction." However, this assertion appears to conflict with the Answer's own indication that the cited section teaches that the "browser displays" to the user a selection, then "the customer provides appropriate information" regarding the display, and then "the transaction executor component formats a message to the external provider." Thus, the transaction executor component formatting relies and is responsive to an input by the customer. Claim 1 recites that an automated banking

machine "transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device."

The cited section does not teach an HTML document including an instruction to cause operation of a transaction function device of an automated banking machine. Nor is there a teaching that a browser processes an HTML document instruction to operate a transaction function device. As discussed in more detail in the Appeal Brief, Zeanah's browser (at best) is for displaying web pages, it is not associated with processing transaction function device operating instructions. Zeanah does not teach the recited processing software.

Furthermore, the Answer's apparent reliance on additional "known" prior art (page 15, lines 9-10) in an anticipation rejection is questioned. Also, the record lacks substantial evidence support regarding the alleged "known" prior art. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

35 U.S.C. § 103(a)

Appellants' Appeal Brief provides detailed explanations as to why the pending claims are not obvious. The Office does not factually support any *prima facie* conclusion of obviousness.

The Answer again admits (on page 16) that Zeanah does not disclose "dispensing at least one note/currency." It follows that Zeanah cannot teach the dispensing of a note through operation of a note dispenser responsive to at least one mark up language document. McLean also does not teach or suggest the dispensing of a note through operation of a note dispenser responsive to at least one mark up language document. The Answer (and the Office Action from

which the appeal was taken) is silent as to McLean even being associated with a mark up language document.

Reduction to Practice

Appellants respectfully submit that the Declaration filed February 4, 2002 effectively swears back prior to July 7, 1996. The Appeal Brief discusses the Declaration (and replies to the Answer) in detail beginning at page 12.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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